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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,699	11/30/2001	Tushar Mangrola	6169-A	4730

7590 09/07/2004

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EXAMINER	
STORK, KYLE R	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/997,699	MANGROLA, TUSHAR	
	Examiner	Art Unit	
	Kyle R Stork	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 November 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the application filed November 10, 2001.

2. Claims 1-8 are pending. Claims 1 and 6 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alam et al. (U.S. 6,336, 124) and further in view of Yalcinalp (U.S. 6,507,857).

As per independent claim 1, Yalcinalp discloses the method of producing a document from data in Extensible Markup Language (XML), comprising steps of:

- Providing an Extensible Stylesheet Language Template (XSLT) transformer having an input and an output and being adapted to respond to XSLT instructions to vary the format of the data received at the input (Figure 2, item 205; column 5, lines 38-40)
- Introducing the XML to the XSLT transformer at the input of the transformer (Figure 2, item 230; column 5, lines 38-40)
- Providing XSLT instructions to the XSLT transformer (Figure 2, item 220)

- Responding to the XSLT instructions to vary the format of the XML data at the input (Figure 2, item 215; column 5, lines 27-30)

Yalcinalp fails to disclose outputting the data from the output of the XSLT transformer in a Form Document Format (FDF). However, Alam discloses converting an XML document to a Portable Document Format (PDF) (Figure 3; column 5, lines 7-9; column 5, lines 29-35), and the applicant discloses that "present methods and apparatus for producing PDF documents take data directly from an application source and put it in a Form Document Format (FDF) to produce the PDF documents" (page 1, lines 22-23). Therefore, Alam inherently discloses conversion from a source document to a FDF.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Yalcinalp's method of using stylesheets and XML to produce a document with Alam's method of producing a document in FDF, since it would have allowed a user to convert an original source document created with XML to produce an FDF and ultimately a PDF (Alam: Figure 3; column 5, lines 7-9; column 5, lines 29-35).

As per dependent claim 2, Yalcinalp and Alam disclose the limitations similar to those in claim 1 and the same rejection is incorporated herein. The applicant further discloses that "present methods and apparatus for producing PDF documents take data directly from an application source and put it in a Form Document Format (FDF) to produce the PDF documents" (page 1, lines 22-23). Alam discloses converting from an

XML document to a PDF document (column 5, lines 7-9; column 5, lines 29-35). Therefore, Alam discloses producing a PDF document from the data in the FDF.

As per independent claim 6, Yalcinalp discloses the apparatus for converting an XML document to another document format including:

- An XSLT
- A transformer having an input and an output, the transformer being adapted to receive the XML data at the input and having properties responsive to the XSLT to provide the data in document format

Yalcinalp fails to disclose the document format as a FDF and further fails to disclose means responsive to the data in the FDF format to produce a PDF document. However, the applicant discloses that "present methods and apparatus for producing PDF documents take data directly from an application source and put it in a Form Document Format (FDF) to produce the PDF documents" (page 1, lines 22-23). Alam further discloses the apparatus to convert from an XML document to a PDF document (Figure 3; column 5, lines 7-9; column 5, lines 29-35). Therefore, Alam discloses the FDF document format and the means responsive to the data in the FDF format to produce a PDF document.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Yalcinalp's apparatus for transforming XML input with a XSLT to produce an output with Alam's apparatus for producing PDF documents from an FDF document, since it would have allowed a user to convert XML documents to PDF documents (column 5, lines 7-9; column 5, lines 29-35).

5. Claim 3-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alam and Yalcinalp and further in view of Parker et al. (U.S. 6,441,919).

As per dependent claim 3, Alam and Yalcinalp disclose the limitations similar to those in claim 2, and the same rejection is incorporated herein. Alam and Yalcinalp fail to disclose the method wherein the producing steps include the steps of:

- Providing a PDF form
- Merging the data in the FDF format into the PDF form to produce the PDF document

However, Parker discloses:

- Providing a PDF form (column 2, lines 23-28: Here, the reusable objects and the page layout information are a PDF, this is further described in column 6, lines 53-65)
- Merging the data in the FDF format into the PDF form to produce the PDF document (column 2, lines 23-28; column 2, lines 41-44)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam and Yalcinalp's method of producing a PDF file from an XML file and XSLT with Parker's method of using PDF forms to determine the layout of a document since it would have allowed a user to have different forms filled in with PDF information.

As per dependent claim 4, Alam, Yalcinalp, and Parker disclose the limitations similar to those in claim 3, and the same rejection is incorporated herein. Parker further discloses the method wherein the step of providing a PDF form includes the step of

providing the PDF form graphically (column 6, lines 53-65: Here, it is asserted that a PDF form object is treated as a reusable object; column 1, lines 10-26: Here, a reusable element is graphically rendered and stored in a cache. This asserts that a PDF form can be graphically provided).

As per dependent claim 5, Alam, Yalcinalp, and Parker disclose the limitations similar to those in claim 4, and the same rejection is incorporated herein. Alam further discloses the method of scanning a document to produce another document (Figure 6, items 502, 504, and 510).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam's method of scanning a document to create a document image with Alam, Yalcinalp, and Parker's method of providing a PDF form graphically, since it would have allowed a user to provide a paper PDF form document and have the PDF form document be rendered and cached in memory for printing (Parker: column 1, lines 10-23).

As per dependent claim 7, Alam and Yalcinalp disclose the limitations similar to those in claim 6, and the same rejection is incorporated herein. Alam and Yalcinalp fail to disclose the apparatus wherein the means responsive to the data in the FDF format, comprises means for merging the data in the FDF format into a PDF form to produce a PDF document. However, Parker discloses the apparatus wherein the means responsive to the data in the FDF format, comprises means for merging the data in the FDF format into a PDF form to produce a PDF document (column 2, lines 23-28; column 2, lines 41-44; column 6, lines 53-65).

As per dependent claim 8, Alam, Yalcinalp, and Parker disclose the limitations similar to those in claim 7, and the same rejection is incorporated herein. Alam further discloses the apparatus of scanning a document to produce another document (Figure 6, items 502, 504, and 510).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam's apparatus of scanning a document to create a document image with Alam, Yalcinalp, and Parker's apparatus for providing a PDF form graphically, since it would have allowed a user to provide a paper PDF form document and have the PDF form document be rendered and cached in memory for

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nussbaum et al. (U.S. 6,779,154): Discloses a XML to HTML converter.
- Gartland (U.S. 6,144,974): Discloses different page layouts of documents.
- Stevens (U.S. 2002/0143823): Discloses an XML translator.
- Day et al. (U.S. 2002/0194227): Discloses file processing and document conversion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R Stork whose telephone number is (703) 605-1203. The examiner can normally be reached on Monday-Friday (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER